

Appln. No.: 10/017,382  
Amendment dated December 29, 2005  
Reply to Office Action of October 4, 2005

### REMARKS/ARGUMENTS

The Office Action of October 4, 2005, has been carefully reviewed and these remarks are responsive thereto. Applicants have amended claims 14 and 15. Reconsideration and allowance of the instant application are respectfully requested.

#### *Allowed Subject Matter*

Claims 2-3 and 9-11 are objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form, including the limitations of any intervening claims. Applicants have not amended claims 2-3 and 9-11 at this time, based on the arguments in favor of allowability of the rejected base claims as set forth below.

#### *Rejections Under 35 U.S.C. § 103*

Claims 1, 4-6 and 12-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nelson *et al.* (U.S. 2002/0004424, hereinafter Nelson) in view of Freda, III (U.S. Pat. No. 5,660,389, hereinafter Freda). This rejection is respectfully traversed for at least the following reasons.

#### No Motivation to Combine the References

The Office Action indicates that it would have been obvious to combine Nelson and Freda "in order to facilitate interaction play between the players." However, this is not a motivation to combine the references, but is the end-result of the combination *taught by Applicant's own disclosure*. That is, *the combination was made only made after the Office benefited from reading Applicant's own application* to learn that such a combination was desirable. There is no suggestion or motivation identified in the Office Action to combine the references, and thus the combination is the result of impermissible hindsight reasoning.

Even assuming that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, as is often argued by the Office, the Office Action provides no evidence that the combination takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, nor does the Office

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Action provide any evidence that the combination does not include knowledge gleaned only from Applicant's disclosure, as would be required in order to make such a combination.

The Federal Circuit has repeatedly stated that the limitations of a claim in a pending application cannot be used as a blueprint to piece together prior art in hindsight, *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), and that the Patent Office should *rigorously* apply the requirement that a teaching or motivation to combine prior art references needs to be provided. *Id.* (emphasis added). Thus, Applicants respectfully submit that that there would have been no motivation or suggestion to combine Nelson with Newman at the time of the claimed invention, and that the Office Action does not establish a *prima facie* case of obviousness.

In addition, to combine the references defeats the purpose of Nelson. Even if Nelson were somehow combined with Freda, the combination would provide a game whereby a player can answer a question, pass the question and receive another question, or pass the question to a competing team. However, in Nelson, the teams that answer correctly win or score. Teams do not want competitor teams to do well, and thus would explicitly not want to pass a question to another team, thereby increasing the passing team's chances of losing the game. The only reason for passing the question to the next team would be that a player wants the other team to beat the player's own team. Quite simply, to provide a function in Nelson whereby a team could pass a question to a competing team would defeat the purpose of Nelson. Add to that the fact that Nelson indicates that multiple teams receive the question at the same time, and there is no need to modify Nelson with the teachings of Freda in the first place. That is, if each team receives the question, why bother modify Nelson with the ability to pass a question to a competing team, as is allegedly suggested in Freda?

Claims 7-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nelson in view of Newman (U.S. 2002/0133562). This rejection is respectfully traversed.

For succinctness, Applicants refer the Office to Applicants' arguments made against the combination of Nelson and Newman in the response dated April 8, 2005. Applicants also direct the Office to arguments regarding the deficiency that neither Nelson nor Newman describe the

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ability to pass a question to another player, as claimed in claim 1, from which claims 7 and 8 ultimately depend.

In addition, with respect to claim 8, neither Newman nor Nelson describe the *ability of a mobile terminal to record* audio and/or video and send such recorded audio and/or video as part of a *response* to a task. Newman, allegedly, merely indicates that a question may include audio and/or video, not that a response to a question includes audio and/or video.

#### ***Rejections Under 35 U.S.C. § 102***

Claims 14-20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Newman. This rejection is respectfully traversed for at least the following reasons.

Applicants have amended claim 14 to clarify that the mobile terminal presents at least *two* response options to a user of the mobile terminal, i.e., submitting a task response to the game server, *and* forwarding the task to a different mobile terminal. Newman and Nelson only describe sending a response to the game server, and do not describe forwarding the task to a different mobile terminal. Claims 15-20 are dependent back to claim 14 and therefore allowable for at least the same reasons as claim 14.

#### ***Claim 46***

Applicants respectfully note that the Office Action does not address claim 46. In addition, assuming this is an oversight, it is not clear to applicants or their representative the basis on which the Office might have intended to reject claim 46, since claim 46 has a different scope than other independent claims. Applicants thereby proceed with the understanding that claim 46, in its present form, is allowable. Should the Office disagree, Applicants would appreciate the opportunity to respond to a subsequent non-final rejection of claim 46.

### **CONCLUSION**

All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and solicit prompt notification of the same. However, if

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for any reason the examiner believes the application is not in condition for allowance or there are any questions, the examiner is requested to contact the undersigned at (202) 824-3153.

Respectfully submitted,

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Dated this 29th day of December, 2005

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